

REMARKS

I. INTRODUCTION

Claims 1-9 are pending in the present application. Applicants would like to thank the Examiner for allowing claim 9. However, in view of the following remarks, it is respectfully submitted that all presently pending claims are in condition for allowance.

II. THE 35 U.S.C. § 101 REJECTION SHOULD BE WITHDRAWN

Claims 1-8 stand rejected under 35 U.S.C. § 101 for failing to fall within one of the four statutory categories of invention. (See 3/24/09 Office Action, p. 2). Specifically, the Examiner asserts that a method/process claim must be tied to another statutory class of invention or transform underlying subject matter to a different state or thing. (See Id, p. 3.).

Applicants direct the Examiner's attention to the recent Federal Circuit opinion *In re Bilski* (hereinafter "Bilski"). (See *In re Bilski*, Appeal No. 2007-1130, Fed. Cir. Oct. 30, 2008). Specifically, Applicants direct the Examiner's attention to the following excerpt from the Bilski opinion:

We hold that the Applicants' process as claimed does not transform any article to a different state or thing. Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances. Applicants' process at most incorporates only such ineligible transformations. See Appellants' Br. at 11 ("[The claimed process] transforms the relationships between the commodity provider, the consumers and market participants..."). As discussed earlier, the process as claimed encompasses the exchange of only options, which are simply legal rights to purchase some commodity at a given price in a given time period. See J.A. at 86-87. The claim only refers to "transactions" involving the exchange of these legal rights at a "fixed rate corresponding to a risk position." See '892 application cl.1. **Thus, claim 1 does not involve the transformation of any physical object or substance, or an electronic signal representative of any physical object or substance.** Given its admitted failure to meet the machine implementation part of the test as

well, the claim entirely fails the machine-or-transformation test and is not drawn to patent-eligible subject matter. (See *Bilski*). (Emphasis added).


While the Examiner states that the current position of the PTO is that patent-eligible subject matter must be tied to another statutory class or transform underlying subject matter to different state or thing, it is important to note the Federal Circuit's inclusion of "an electronic signal representative of any physical object or substance" within its description of patent-eligible subject matter. (See *Id.*). One skilled in the art would understand that a medical image is an electronic signal representative of a physical object, namely, the anatomical features of a patient. The specification provides several examples of anatomical features included in medical images including anatomical structures related to blood flow and gastric reflux (See Specification, ¶ [0002]), heart muscle or myocardium (See *Id.*, ¶ [0003]), the diaphragm (See *Id.*, ¶ [0013]), and body tissue (See *Id.*, ¶ [0014]). Accordingly, the process of transforming this electronic signal representative of a physical object (anatomical structures) would clearly fit within the Federal Circuit's description of patent-eligible subject matter, as detailed in the *Bilski* opinion. Therefore, claim 1 performs a transformation of an electronic signal representative of a physical object. Thus, Applicants respectfully submit that the rejection to claim 1 should be withdrawn. As claims 2-8 depend from, and therefore include all the limitations of claim 1, it is hereby submitted that these claims are also allowable.

CONCLUSION

In view of the remarks submitted above, Applicants respectfully submit that all presently pending claims are in condition for allowance. All issues raised by the Examiner have been addressed, and a favorable action on the merits is thus earnestly requested.

Respectfully submitted,

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